

*Contd*  
a mirror housing assembly including a reflective element normally facing in a direction for viewing rearward; and

an electrically powered folding mechanism operably folding and maintaining the mirror between a rearward and a forward direction, wherein the mirror housing is operable to travel a greater distance in the forward direction relative to the distance traveled in the rearward direction, whereby the overall width dimension of the vehicle is reduced.

The marked-up version of the claims is shown at the end of the instant response.

#### REMARKS

Claims 1-19 are pending in the application.

Claims 2-5, 7-9 and 11-19 have been withdrawn from consideration.

Claims 1, 6 and 10 stand rejected.

Claim 1 has been amended. Support for this amendment can be found throughout the specification and drawings, as originally filed.

#### REJECTION UNDER 35 U.S.C. 102(e)

Claims 1 and 6 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,903,402 to Hoek (hereinafter referred to as "Hoek '402").

Applicant respectfully traverses the rejection.

The law is clear that anticipation requires that the invention be described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent. 35 U.S.C. 102(e).

The law is also clear that a claim in dependent form shall be construed to

incorporate all the limitations of the claim to which it refers. 35 U.S.C. 112, fourth paragraph.

Without admission that any amendment is required, and in the interests of expediting prosecution of the instant application, the Applicant has amended claim 1 to recite that an exterior mirror for a vehicle comprises: (1) a mirror housing assembly including a reflective element normally facing in a direction for viewing rearward; and (2) an electrically powered folding mechanism operably folding and maintaining the mirror between a rearward and a forward direction, wherein the mirror housing is operable to travel a greater distance in the forward direction relative to the distance traveled in the rearward direction, whereby the overall width dimension of the vehicle is reduced.

Hoek '402 discloses no such structure.

Specifically, Hoek '402 fails to disclose that the mirror housing is positioned electrically (Hoek '402 discloses a manually operated spring mechanism). Hoek '402 also fails to disclose that the mirror housing moves forwardly and rearwardly, despite the Examiner's assertion to the contrary. Figs. 1 and 12 of Hoek '402 do not illustrate that the mirror housing is positioned in a forward position. Rather, these figures appear to merely illustrate the telescopic nature of the mirror housing. Additionally, Hoek '402 fails to disclose that the mirror housing travels a greater distance in a forward position as compared to the distance traveled in the rearward position. For at least these reasons, Hoek '402 does not anticipate the claimed invention.

Accordingly, the 35 U.S.C. 102(b) rejection of claims 1 and 6 has been overcome.

Furthermore, the Applicant submits that Hoek ('402) does not render claims 1 and 6 obvious.

The standard for obviousness is that there must be some suggestion, either in

the reference or in the relevant art, of how to modify what is disclosed to arrive at the claimed invention. In addition, “[s]omething in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making” the modification to the art suggested by the Examiner. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051, 5 U.S.P.Q.2d (BNA) 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988). Although the Examiner may suggest the teachings of a primary reference could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the desirability of such modification. *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d (BNA) 1397, 1398 (Fed. Cir. 1989). There must be a teaching in the prior art for the proposed combination or modification to be proper. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d (BNA) 1248 (Fed. Cir. 1989). If the prior art fails to provide this necessary teaching, suggestion, or incentive supporting the Examiner’s suggested modification, the rejection based upon this suggested modification is error and must be reversed. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d (BNA) 1566 (Fed. Cir. 1990).

As previously noted, the Applicant has amended claim 1 to recite that an exterior mirror for a vehicle comprises: (1) a mirror housing assembly including a reflective element normally facing in a direction for viewing rearward; and (2) an electrically powered folding mechanism operably folding and maintaining the mirror between a rearward and a forward direction, wherein the mirror housing is operable to travel a greater distance in the forward direction relative to the distance traveled in the rearward direction, whereby the overall width dimension of the vehicle is reduced.

It is the Applicant’s understanding that Hoek ‘402 merely discloses a telescoping mirror that can be positioned in a rearward direction only (relative to the normal operating position of the mirror) so as to enable the driver of the vehicle to observe a load being towed by the vehicle. As noted, Figs. 1 and 12 are unclear as to whether the

mirror housing has moved in a forward or rearward direction relative to its normal operating position. Additionally, there is no disclosure or suggestion by Hoek '402 that the mirror be capable of also being positioned in a forward direction (relative to the normal operating position of the mirror), as the stated purpose of Hoek ('402) is to enable enhanced rearward viewing only (see especially column 6, lines 59-66). Also, there is no mention by Hoek '402 that the mirror housing travels a greater distance in a forward position as compared to the distance traveled in the rearward position. Further, there is no mention by Hoek '402 that the disclosed mirror is to be positioned so as to decrease the overall width of the vehicle, e.g., for purposes of safely transporting the vehicle without damaging the mirrors during transit.

Therefore, one of ordinary skill in the art would not look to Hoek '402 for guidance on constructing a mirror that is capable of being directed forwardly and rearwardly relative to the normal operating position of the mirror, wherein the mirror housing travels a greater distance in a forward position as compared to the distance traveled in the rearward position.

Accordingly, the Applicant submits that Hoek ('402) does not render claims 1 and 6 obvious.

#### **REJECTION UNDER 35 U.S.C. 102(e)**

Claims 1 and 6 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,130,514 to Oesterholt et al. (hereinafter referred to as "Oesterholt '514").

The Applicant respectfully traverses the rejection.

As previously noted, the Applicant has amended claim 1 to recite that an exterior mirror for a vehicle comprises: (1) a mirror housing assembly including a reflective

element normally facing in a direction for viewing rearward; and (2) an electrically powered folding mechanism operably folding and maintaining the mirror between a rearward and a forward direction, wherein the mirror housing is operable to travel a greater distance in the forward direction relative to the distance traveled in the rearward direction, whereby the overall width dimension of the vehicle is reduced.

Oesterholt '514 discloses no such structure.

Specifically, Oesterholt '514 fails to disclose that the mirror housing travels a greater distance in a forward position as compared to the distance traveled in the rearward position. For at least these reasons, Oesterholt '514 does not anticipate the claimed invention.

Accordingly, the 35 U.S.C. 102(b) rejection of claims 1 and 6 has been overcome.

Furthermore, the Applicant submits that Oesterholt '514 does not render claims 1 and 6 obvious.

Oesterholt '514 discloses that the mirror housing travels a lesser distance during forward positioning as compared to the distance traveled during rearward positioning (see Figs. 2A-2C). This is exactly opposite of the claimed invention.

Therefore, one of ordinary skill in the art would not look to Oesterholt '514 for guidance on constructing a mirror that is capable of being directed forwardly and rearwardly relative to the normal operating position of the mirror, wherein the mirror housing travels a greater distance in a forward position as compared to the distance traveled in the rearward position.

#### **REJECTION UNDER 35 U.S.C. 103(a)**

Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over

Hoek '402 in view of U.S. Patent No. 6,116,743 to Hoek (hereinafter referred to as "Hoek '743").

The Applicant respectfully traverses the rejection.

Because independent claim 1 is allowable over Hoek '402 for at least the reasons stated above, dependent claim 10, a claim that is properly dependent on independent claim 1, is likewise allowable. Furthermore, the citation of Hoek '743 does not cure the previously discussed deficiencies in the teachings of Hoek '402. Specifically, Hoek '743 appears to merely disclose that the mirror housing only travels in a rearward position for enhanced rearward viewing (see Fig. 3 and column 4, lines 8-13).

Therefore, one of ordinary skill in the art would not look to either Hoek '402 or Hoek '743, alone or in combination, for guidance on constructing a mirror that is capable of being directed forwardly and rearwardly relative to the normal operating position of the mirror, wherein the mirror housing travels a greater distance in a forward position as compared to the distance traveled in the rearward position.

Accordingly, the 35 U.S.C. 103(a) rejection of claim 10 has been overcome.

#### **REJECTION UNDER 35 U.S.C. 103(a)**

Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Oesterholt '514 in view of Hoek '743.

The Applicant respectfully traverses the rejection.

Because independent claim 1 is allowable over Oesterholt '514 for at least the reasons stated above, dependent claim 10, a claim that is properly dependent on independent claim 1, is likewise allowable. Furthermore, the citation of Hoek '743 does not cure the previously discussed deficiencies in the teachings of Oesterholt '514. Specifically, Hoek '743 appears to merely disclose that the mirror housing only travels in

a rearward position for enhanced rearward viewing (see Fig. 3 and column 4, lines 8-13), which contradicts the teachings of Oesterholt '514.

Therefore, one of ordinary skill in the art would not look to either Oesterholt '514 or Hoek '743, alone or in combination, for guidance on constructing a mirror that is capable of being directed forwardly and rearwardly relative to the normal operating position of the mirror, wherein the mirror housing travels a greater distance in a forward position as compared to the distance traveled in the rearward position.

Accordingly, the 35 U.S.C. 103(a) rejection of claim 10 has been overcome.

### CONCLUSION

It is respectfully submitted that the claims, as amended, are patentably distinguishable because the cited patents, whether taken alone or in combination, do not teach, suggest or render obvious, the present invention. Therefore, applicant submits that the pending claims are allowable, which allowance is respectfully requested.

The Examiner is invited to telephone the applicant's undersigned attorney at (248) 364-4300 if any unresolved matters remain.

Please send all future correspondence relating to this application to Warn, Burgess & Hoffmann, P.C., P.O. Box 70098, Rochester Hills, MI 48307.

Respectfully submitted,

WARN, BURGESS & HOFFMANN, P.C.  
Attorneys for Applicant(s)

Dated: Jan 31, 2013

By: 

Philip R. Warn

Reg. No. 32,775

Preston H. Smirman

Reg. No. 35,365

P.O. Box 70098  
Rochester Hills, MI 48307  
(248) 364-4300  
PRW/PHS/acw

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS**

The claims have been rewritten as follows:

Claim 1. (Thrice Amended) An exterior mirror for a vehicle comprising:  
a mirror housing assembly including a reflective element normally facing in a  
direction for viewing rearward; and

[a] an electrically powered folding mechanism operably folding and maintaining  
the mirror [in] between a rearward and a forward direction, wherein the mirror housing is  
operable to travel a greater distance in the forward direction relative to the distance  
traveled in the rearward direction, whereby the overall width dimension of the vehicle is  
reduced.